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TOWNSEND and TOWNSEND and CREW LLP

By:

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of:

Jeffrey J. Grainger

Application No.: 09/996,338

Filed: November 27, 2001

For: METHOD OF CREATING
ELECTRONIC PROSECUTION
EXPERIENCE FOR PATENT
APPLICANT

Customer No.: 20350

Confirmation No. 1985

Examiner: Janice Mooneyham

Art Unit: 3629

APPELLANT'S REPLY BRIEF
UNDER 37 CFR § 41.41

Via EFS-Web
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is submitted in response to the Examiner's Answer
mailed May 19, 2006. The following remarks are intended to further focus the issues in
this appeal.

1. Real Party in Interest

The real party in interest statement of the Examiner, "FTF Technologies, Inc.," is correct.

2. Related Appeals and Interferences

The Examiner indicated a possible related appeal, namely Application No. 09/997,311. However, it should be noted that this case is no longer on appeal as a non-final Office Action was issued in this case on June 12, 2006 in response to the Appeal Brief filed March 1, 2006.

3. Status of Claims

Claims 4-9, 11-13 and 19-34 are currently pending in the application. Claims 1-3, 10 and 14-18 have been canceled. Claims 4-9, 11-13 and 19-34 stand rejected pursuant to a Final Office Action mailed January 14, 2005 (hereinafter "the Final Office Action"). The rejections of claims 4-9, 11-13 and 19-34 are believed to be improper and are the subject of this appeal.

3. Grounds of Rejection:

Claims 4-9, 11-13 and 19-34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,434,580 (hereinafter "Takano") in view of U.S. Patent 6,584,466 (hereinafter, "Serbinis"). Paragraphs 3 (et seq.) and 4 (et seq.) of the Final Office action summarize the Examiner's position on this issue.

3. **Response to Examiner's Argument:**

In the Examiner's Answer, the prior rejections were maintained and additional comments were presented in response to the Appeal Brief filed January 20, 2006. Appellant stands on the arguments presented in the Appeal Brief and presents the following comments directed to the Examiner's Answer.

A. The cited references fail to teach each element of any claim at issue on appeal.

In response to this argument, the Examiner contends that "features upon which appellant relies (i.e., for multiple, unrelated companies or technology developers or multiple independent entities) are not recited in the rejected claim(s)." Claims 19 and 20 both recite in part "a plurality of different and unrelated technology developers." The Examiner then argues that this language can be interpreted to mean inventors that are in different departments of the same company. However, the detailed description states that "technology developers include corporations, universities and individual inventors" and that "these multiple technology developers are separate entities that likely have no relation to each other." (Page 9, lines 16-17 and page 8, lines 24-25) In light of this definition, appellant respectfully argues that the Examiner's interpretation of the plurality of different and unrelated technology developers is overly broad since inventors working for the same company cannot reasonably be considered to be unrelated. Therefore, as explained in the Appeal Brief, even if taken together, Takano and Serbinis fail to teach or suggest the elements of the pending claims, which are directed generally to methods and systems for managing intellectual property for a plurality of unrelated entities, such that access to patent application-related documents needs to be managed.

i. Takano and Serbinis each fail to teach or suggest user roles.

In response to this argument, the Examiner points to portions of Serbinis that relate to group-level access control. However, as stated in the Appeal Brief, Serbinis fails to teach or suggest the use of permissions associated with user roles, as recited by claim 19, 20 and 27. As recited by claims 19, 20 and 27, however, the concept of a user role having associated permissions is distinct from the concept of group permissions. This can be seen easily from the text of claims 19, 20 and 27 themselves, which recite, as a basis of determining if the user can perform an operation, both the “group to which the user is assigned” and “the set of permissions associated with the one or more roles to which the user is assigned.” Hence, the group-level permissions taught by Serbinis fail to teach or suggest the user roles recited in claims 19, 20 and 27.

Other portions of Serbinis deal with permissions assigned to specific users, not to user roles. Serbinis describes how specific authorized users are granted user-level permissions, which have nothing to do with their role. Hence, taken either alone or in combination, neither Takano nor Serbinis teaches nor suggests “determining . . . one or more roles to which the user is assigned” and based, *inter alia*, on “the set of permissions associated with the one or more roles” determining “if the user can perform the operation on the electronic document,” as recited by claims 19, 20 and 27.

ii Takano and Serbinis fail to teach or suggest the recited combination of permissions.

Claims 19 and 20 each recite, *inter alia*, maintaining and enforcing rights to electronic documents, including in particular “determining (i) a first group to which the user is assigned; (ii) a second group to which the electronic document is assigned; (iii) one or more roles to which the user is assigned, (iv) unit level access information for the

particular collection of electronic documents and (v) if the user can perform the operation on the electronic document based upon the first group to which the user is assigned, the second group to which the particular collection of electronic documents is assigned, the set of permissions associated with the one or more roles to which the user is assigned and the unit level access information for the particular collection of electronic documents.

Somewhat similarly, claim 27 recites “determining a first group to which the first user is assigned; determining a second group to which the first collection is assigned; determining one or more roles to which the first user is assigned and determining if the user can perform the operation on the electronic document in the first collection based upon the first group to which the user is assigned, the second group to which the first collection is assigned and the set of permissions associated with the one or more roles to which the user is assigned.”

Neither Takano nor Serbinis teaches or suggests this particular procedure for maintaining and enforcing rights to access electronic documents and data. Even assuming Serbinis teaches user roles and associated permissions (which, as noted above, it does not), neither Serbinis nor Takano teaches the use of a particular combination of (i) a user group, (ii) a document group, and (iii) permissions associated with user roles to determine whether a user can perform an operation on an electronic document, as recited by claim 27. *A fortiori*, Serbinis and Takano each fail (either individually or collectively) to teach or suggest using this combination, along with (iv) unit-level access information, to make such a determination, as recited by claims 19 and 20.

iii. Takano and Serbinis fail to teach or suggest determining rights to file a patent application.

The appellant has argued that the references fail to teach or suggest “determining if the client system has appropriate rights to file the particular patent

application and, if so, causing the patent application to be filed in the patent office in response to the request,” as recited by claim 19. In response, the Examiner argues that “since appellant’s specification does not disclose how or what makes the determination of whether the client system has appropriate rights to file the patent application, the Examiner will broadly interpret this language.” However, as discussed above and cited in the Appeal Brief, the specification provides descriptions and numerous examples of how a user’s role etc. can be used to determine a user’s rights including a user’s right to file a patent application. For example, see Fig. 8 and the accompanying detailed description including paragraphs 54G-54H.

The Examiner then goes on to argue that since the draft uploading means of Takano delivers the draft data to the application document transmitting means, the client computer has rights to file the patent application. That is, the Examiner seems to be arguing that since Takano’s client computer makes the application documents available for transmission, it must have permission to do so. However, as discussed in the Appeal Brief, nothing in Takano teaches or suggests determining that a user has sufficient rights to perform a filing operation. Hence, the combination of Takano and Serbinis fails to teach or suggest these additional elements of claims 19 and 20.

iv. Takano and Serbinis fail to teach or suggest presenting questions to a user.

Dependent claim 8 recites in part that “the plurality of invention disclosures are generated by responding to questions presented to users in the first plurality of users by the server via a Web page.” Neither of the cited references teaches or suggests this element, and claim 8 is allowable over the cited references for this additional reason.

The Examiner has cited a portion of Takano directed to presenting a template to be completed. However, Takano does not teach presenting questions for users to respond to. Instead, the cited portion of Takano teaches presenting a template with blanks to be filled in and the Examiner then equates filling in the template blanks with answering questions.

Providing a template for a specification form is in no way similar to presenting questions to be answered by an inventor. Merely by way of example, Figs. 3A-3L of the Application illustrate exemplary web pages presenting questions for a user to answer. This novel feature of certain embodiments provides many more benefits than merely presenting a template for a user. For instance, the questions can be phrased in an easy-to-understand manner, reducing the intimidation many inventors face when attempting to disclose an invention.

By contrast, the system of Takano merely “reads the template data, fetched by the template down loading means 105 into the text preparation software (step B4), and completes the draft data for the specification for patent application by having the inventor enter the text data in addition to the template data.” (Takano, c. 9, ll. 32-37) That is, Takano’s template system simply provides some data for the user and then requires the user to enter additional information.

For at least the reasons above, the combination of Takano and Serbinis fails to teach or suggest each limitation of any claim at issue on appeal, and for at least that reason, the cited combination fails to create a prima facie case of obviousness under § 103(a), and the rejections therefore should be reversed.

For the remainder of the issues on appeal the appellant stands on the arguments presented in the Appeal Brief. For at least these reasons, Appellant believes that the rejections of claims 4-9, 11-13 and 19-43 under 35 U.S.C. § 103 (a) are improper.

Furthermore, since all other claims depend upon allowable base claims and for other reasons as presented in the Appeal Brief, it is respectfully submitted that the Examiner's rejections of the claims should be reversed.

Respectfully submitted,



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